



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,849	09/22/2000	Robert M. Berton	426882000400	2900

20872 7590 04/23/2003
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,849

Applicant(s)

BERTON ET AL.

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 13, 15 - 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 13, 15 - 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 March 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The office action of 12/26/2002 rejected claims 1 - 20.

Applicant amendment of 03/13/2003 amended claims 1, 3, 5 - 7, 9 - 13, 15 and 18 - 20 as well as canceled claims 2 and 14. Moreover, applicant traversed rejections of claims 1 - 20.

Currently, claims 1, 3 - 13 and 15 - 20 are pending.

Response to Arguments

Applicant's arguments with respect to claims 1 - 20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 is dependent from claim 2, which was canceled by applicant. As a result, claim 4 is indefinite. However for examination purposes, claim 4 will be treated as definite and dependent from claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 10, 13, 18 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over SiCommNet (here after referred to as SiComm) in view of “For State of Washington AMS Buy Plan Made lots of Sense State of Washington awards two-year e-procurement solution contract to American Management Systems”; Washington Technology; page 40; July 3, 2000.

Regarding claim 1 and related claims 10, 13, 18 - 20 (Currently Amended), SiComm teaches a computer related method and system for funding a state government procurement system comprising the acts of:

- a. providing an internet-based procurement system by a services provider for use by a state government agency for procurement of goods and services (Page 2, Para 1);
- b. providing an Internet portal for use by the state government agency to communicate electronically with the internet-based procurement system (Page 2, Para 1).

While SiComm does teach providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency, whereby the

vendor pays a fee to the services for an opportunity to be connected to the internet-based procurement system, SiComm does not specifically disclose and teach wherein the fee paid by the vendor is a percentage of the costs of the goods and/or services provided to the state by the vendor.

However, AMS does disclose and teach c. providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency, whereby the vendor pays a fee to the services for an opportunity to be connected to the internet-based procurement system, wherein the fee paid by the vendor is a percentage of the costs of the goods and/or services provided to the state by the vendor (Page 2, Para 8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of SiComm with the method and system of AMS to enable providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency, whereby the vendor pays a fee to the services for an opportunity to be connected to the internet-based procurement system, wherein the fee paid by the vendor is a percentage of the costs of the goods and/or services provided to the state by the vendor – in order to provide additional revenue for the both the service provider and the Agency. In that regard, the cost to tax payers for government services will be reduced, possibly reducing taxes and as importantly demonstrating that Government is becoming more efficient and effective too.

Claims 3, 5 - 7, 9, 11, 12, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of SiComm and AMS, and further in view of “NIC Launches Industry’s First Comprehensive Suite of eGovernment Solutions For Citizens, Business and Government”; PR Newswire; New York; June 1, 2000 (hereafter referred to as NIC I) and NICUSA web pages captured via the WayBack Machine (hereafter referred to as NIC II).

Regarding claim 5 and related claims 9, 12 (Currently Amended) and 17, the combination of SiComm and AMS teach an internet based method for use in an eProcurement system by a state government agency comprising the following acts: providing a web site having a user interface (UI), wherein the UI includes user input and display windows for use by a state government agency user; receiving at the web site user inputs indicative of a desired product or service and wherein the cost of the eProcurement system is funded by fees comprising payments from participating vendors, payments by investment from the services provider, payments by transaction fees collected from-users customers comprising persons seeking services from a state agency through use of eProcurement system and payments of reduced fees from the state government agency – as well as fees being returned in partial payment to the services provider.

However, the combination of SiComm and AMS does not specifically disclose and teach determining from the user inputs whether the user is a state employee seeking a purchase of goods and/or services for the state or whether the user is a citizen or other customer seeking to purchase a good and/or service from the state; determining from a database whether the desired product or service is available from a state agency or from a qualified vendor wishing to sell goods and/or services to the state government agency, whereby the vendor pays a fee to services for the opportunity to be connected to the eProcurement system; and providing information regarding the availability of the desired product or service to the state government agency user whether this user is a state employee or a customer of state services,

On the other hand, NIC I and II teaches determining from the user inputs whether the user is a state employee seeking a purchase of goods and/or services for the state or whether the user is a citizen or other customer seeking to purchase a good and/or service from the state (NIC I, page 2, para 2 and page 3, para 4 as well as NIC II, pages 4 – 5 and 7 - 8); determining from a database whether the desired product or service is available from a state agency or from a qualified vendor wishing to sell goods and/or services to the state government agency (NIC I, pages 1 – 4), whereby the vendor pays a fee to services for the opportunity to be connected to the eProcurement system (NIC I, page 4); and providing information regarding the availability of the desired product or service to the state government agency user whether this user is a state employee or a customer of state services (NIC I, pages 1 – 4). Moreover:

regarding claim 3 and related claims 7 and 15 (Currently Amended), NIC I teaches a method comprising an additional act of providing an Internet portal for a customer of the state government agency, whereby the customer can execute an electronic transaction, via the internet-based procurement system, with the state government agency in exchange for a fee wherein the customer is one of the group consisting of a person seeking a driver's license, a person seeking a vehicle license a person seeking a voter registration a person seeking a license to practice professionally in the state a person seeking a business registration a person seeking a sales tax certificate person seeking a sales permit and a person seeking a generic state identification document (Page 3, para 4).

regarding claim 6 (Currently Amended), NIC I teaches a method comprising an additional act of providing an Internet portal for use by a qualified vendor wishing to sell goods and/or services to the state government agency, whereby the vendor pays a fee opportunity to be connected to the internet-based procurement system, where the fee paid by the vendor is a percentage of the cost to the state of the goods and/or service provided by the vendor (Page 4, para 6 and Page 5, para 1).

regarding claim 11 (Currently Amended), NIC I teaches a system wherein the computerized eProcurement system for a state government agency is provided by a services provider for use by the state government agency for procurement of goods and

services, where the computerized eProcurement system is funded by fees comprising payments from participating vendors, payments by investment from the services provider, and payments by transaction fees collected from customers comprising persons seeking services from a state agency through use of the computerized eProcurement system (Page 1 – 5).

Please note, NIC I and NIC II do not specifically disclose a database. However, it was well known in that art at the time of the invention that COTS packages as offered by NIC Commerce, as well as other ERP/eProcurement COTS packages incorporate a database function – whether incorporating an off the shelf DBMS such as Oracle or as some such as SAP, who originally developed proprietary DBMS's. The Agency specific information then would be loaded into the database in order to provide the requisite data required by the various Portal software applications/modules. With regard to determining, NIC I and II do not specifically disclose the act of determining from user inputs whether the user is a state employee seeking a purchase or whether the user is a citizen seeking a purchase of a good or service from the state. However and as depicted in NIC II, page 4 the “determining” occurs when the citizen user is “determined” by the link selected. Moreover and it was well known in the art at the time of invention, Portal software can determine if the user is a state employee through state employee accessing either a separate web site and/or the state intranet web site, securely (https) and therefore the determining is achieved for the state employee - since a citizen is not approved to buy products from state vendors contracts and/or accessing the state

intranet site. Moreover, the state portal/eProcurement intranet site will also incorporate further security through approved state employee/user log in as well as passwords and thereby determining state employee privileges and rights to access various applications as well. These Portal capabilities were well known in the art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of SiComm and AMS with the method and system of NIC to enable determining from the user inputs whether the user is a state employee seeking a purchase of goods and/or services for the state or whether the user is a citizen or other customer seeking to purchase a good and/or service from the state; determining from a database whether the desired product or service is available from a state agency or from a qualified vendor wishing to sell goods and/or services to the state government agency, whereby the vendor pays a fee to services for the opportunity to be connected to the eProcurement system; and providing information regarding the availability of the desired product or service to the state government agency user whether this user is a state employee or a customer of state services as well as the portal capabilities for a fee. In that regard, the State can provide for a fee, procurements services to both internal state employees as well as citizens seeking to procure licenses. Indeed, this Portal will provide all the functionality required to support all users – thereby increasing the effectiveness as well as cost effectiveness of government. With this decrease in cost to the state as well as increase availability and ease of use by

citizens and other constitutes as well as stakeholders - will increase the satisfaction of all and over time possibly decrease taxes too.

Claims 4, 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of SiComm, AMS and NIC I and II as applied to claims 1, 6 and 13 above, and further in view of "Auctions Pay Dividends for Gov't"; L.S. Tillet; News release; May 2000, www.internetwk.com; 4pgs (hereafter referred to as Auctions).

The combination of SiComm, AMS and NIC I and II disclose and teach substantially the invention.

However, the combination of SiComm, AMS and NIC I and II does not specifically disclose and teach wherein the state government agency is able to use the internet-based procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers.

On the other hand and regarding claim 4 and related claims 8 and 16, Auction teaches a method wherein the state government agency is able to use the internet-based procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers (Page 3, Para 1 and 2).

It would have been obvious to one of ordinary skill in the art to have provided the combination of SiComm, AMS and NIC I and II with the method of Auctions to have provided the capability to use the internet-based procurement system to sell by auction or other methods, obsolete or excess inventory held by the state government agency to interested buyers – and thereby increase the opportunity to reduce inventory cost, gain revenue and thus increase the possibility of decreased taxes, while clearly demonstrating the effectiveness of eGovernment initiatives to taxpayers.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7658 for regular communications and 703.308.3687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER

April 17, 2003

Application/Control Number: 09/668,849
Art Unit: 3625

Page 13



WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800